

REMARKS

Applicant thanks Examiners Rada and Coburn for the personal interview granted to the undersigned on September 9, 2004. Claim 1 and U.S. Patent No. 6,012,961 (Sharpe) were discussed. Additionally, the undersigned demonstrated the invention with a model. In particular, the undersigned provided a first game system in the form of a hand-held device, toy figures in the form of creatures, and a second game system in the form of an action figure device, and demonstrated how the game systems each interact with the toy figures.

Applicant has amended claim 1 as discussed during the interview. Additionally, to supplement the discussion, applicant submits the following additional remarks.

Claims 1-40 are pending with claims 1 and 34 being independent. Applicant thanks Examiner Rada for the indication that claims 34-39 recite allowable subject matter.

Claims 1-40 have been rejected under the judicially created doctrine of obviousness-type double patenting as being obvious over claims 1-36 of U.S. Application No. 10/067,973, now U.S. Patent No. 6,773,325 (the '325 patent). Applicant respectfully submits that the requirement of a terminal disclaimer in the pending application is obviated by the submission of a terminal disclaimer in the '325 patent that disclaims that portion of the term of the '325 patent extending beyond the term of the pending application. Accordingly, applicant requests reconsideration of the requirement of a terminal disclaimer in the pending application.

Independent claim 1 relates to a game including a toy figure, a first game system configured to communicate with the toy figure, and a second game system configured to communicate with the toy figure. The first game system includes a first design that, when communicating with the toy figure, provides a first play pattern with a representation of the toy figure developed from the stored information. The second game system includes a second design that, when communicating with the toy figure, provides one or more second play patterns with the representation of the toy figure developed from the stored information, in which at least one of the second play patterns is distinct from the first play pattern.

Claims 1-3, 5, 7-33, and 40 have been rejected as being obvious over U.S. Patent No. 6,012,961 (Sharpe) in view of U.S. Patent No. 5,752,880 (Gabai) and U.S. Patent No. 5,853,327

(Gilboa). Applicant requests withdrawal of this rejection because Sharpe fails to describe or suggest a second game system configured to communicate with a toy figure and providing at least one second play pattern with a representation of the toy figure, in which the at least one second play pattern is distinct from a first play pattern provided by a first game system.

Sharpe relates to a toy that has re-writeable memory such that a user can download information from a computer into the toy memory to alter operating characteristics of the toy. See Sharpe at col. 1, lines 7-13. However, as discussed during the interview, Sharpe does not describe or suggest a second game system configured to communicate with the toy and provide a second play pattern.

Gabai fails to cure the deficiencies of Sharpe. Gabai relates to a toy that communicates with a computer system. See Gabai at abstract and col. 2, lines 1-8. However, like Sharpe, Gabai does not describe or suggest a second game system configured to communicate with the toy and provide a second play pattern.

Gilboa also fails to cure the deficiencies of Sharpe. Gilboa relates to a board game on which toy figures are positionable by a player. See Gilboa at abstract and Fig. 1. As the player moves the toy figures, a computer senses the location of the toy figures on the board game and outputs an appropriate audio or visual signal. See Gilboa at abstract; col. 6, line 65 to col. 7, line 31; col. 7, line 53 to col. 8, line 29; and Figs. 2A-2E. However, like Sharpe and Gabai, Gilboa does not describe or suggest a second game system configured to communicate with the positionable toy figures.

Accordingly, since all of the cited references fail to describe or suggest a second game system configured to communicate with a toy figure and providing at least one second play pattern with a representation of the toy figure, the at least one second play pattern being distinct from a first play pattern provided by a first game system, any combination of those references similarly fails, and independent claim 1 is allowable over the combination of Sharpe, Gabai, and Gilboa.

Claims 2, 3, 5, 7-33, and 40 depend from claim 1 and are allowable for at least the reasons that the claim 1 is allowable and for containing allowable subject matter in their own

right. For example, claim 10 recites that the input received from a user includes input relating to control of the representation of the toy figure during game play. None of the cited art, alone or in combination, describes or suggests receiving input relating to control of the representation of the toy figure during game play.

Claims 4 and 6 have been rejected as being obvious over Sharpe in view of Gabai, Gilboa, and U.S. Patent No. 5,746,602 (Kikinis), which relates to a doll that is controlled through a computer when the doll is communicating with the computer. See Kikinis at col. 3, lines 23-53 and line 66 to col. 4, line 17. Claims 4 and 6 depend from claim 1, which was rejected as being obvious over Sharpe in view of Gabai and Gilboa. Kikinis fails to cure the deficiencies of Sharpe, Gabai, and Gilboa because Kikinis does not include a second game system configured to communicate with the doll. Accordingly, since Sharpe, Gabai, Gilboa, and Kikinis each fail to describe or suggest a second game system configured to communicate with a toy figure and providing at least one second play pattern with a representation of the toy figure, the at least one second play pattern being distinct from a first play pattern provided by a first game system, any combination of those references similarly fails, and independent claim 1 is allowable over the combination of Sharpe, Gabai, Gilboa, and Kikinis. Claims 4 and 6 are allowable for at least the reasons that claim 1 is allowable.

Applicant : Miriam MAWLE et al.
Serial No. : 09/556,839
Filed : April 21, 2000
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Attorney's Docket No.: 06181-862002

Enclosed is a \$110.00 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: September 24, 2004

Diana DiBerardino

Diana DiBerardino
Reg. No. 45,653

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331

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